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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/110,717	07/07/1998	RANDELL L. MILLS	9113-19-C16	5034

7590 02/11/2005

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EXAMINER

KALAFUT, STEPHEN J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

12

Office Action Summary	Application No.	Applicant(s)	
	09/110,717	MILLS, RANDELL L.	
	Examiner	Art Unit	
	Stephen J. Kalafut	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 38-166 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 38-166 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>(2 dates)</u> . | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/16/2004 has been entered.

Claims 1-28 and 38-166, for reasons of record, are rejected under 35 U.S.C. 101 because the disclosed invention lacks patentable utility. See paper no. 3, paragraph no. 2.

Claims 1-28 and 38-166, for reasons of record, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. See paper no. 3, paragraph no. 3.

Applicant's arguments filed 12/16/2004 have been fully considered but they are not persuasive.

The articles attached to applicant's IDS of 12/16/2004 have been reviewed, along with attachments 95-101 submitted with the IDS of 5/19/2004, attachments numbered 94 and below having been addressed in paper no. 36. These articles are not considered persuasive for various reasons stated in paper no. 36, the reasons being broken down into several categories.

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- 1) Attachments 95-100, 103 and 105-107 fall into category (1), *i.e.*, they have not been peer reviewed, and thus do not have the credibility that peer-reviewed articles have.
- 2) Attachment 106 falls into category (2), because does not deal with the “hydrino”, but other subject matter, specifically in this attachment helium atoms.
- 3) Attachments 98, 99, 101 and 104 fall into category (3), *i.e.*, they contain data not accounted for by applicant’s theory, as explained in paper no. 33, pages 3 and 4.
- 4) Attachments 46, 77, 81, 95-97, 100, 103 and 105 fall into category (4), *i.e.*, they speculate hydrino formation as an explanation for experimental data unrelated to and not necessarily caused by hydrinos, such as Balmer line broadening, calorimetric data, or “indications” of hydride chemical bonding.
- 5) Attachment 102 has not been found.

Much of applicant’s response of 12/16/2004 deals with matters irrelevant to patentability, such as recounts of various interviews. However, the following points are addressed.

Applicant argues (page 20 of the 136-page response) that he has seen “nitpicking” on theoretical grounds, but no fault has been found on “legitimate scientific grounds”. It is submitted that “theoretical” grounds and “scientific” grounds are not separate from each other because science and theory are not mutually exclusive. Instead, theory is a part of science. Moreover, since applicant’s invention is based on a theory which he himself alleges, a consideration of that theory is both legitimate and scientific. Note that category (3), as mentioned above and paper no. 36, and first explained in paper no. 33, pages 3 and 4, compares applicant’s theory to evidence he himself has offered.

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Applicant argues (page 21) that the Office “prefers to engage in a theoretical to the exclusion of [applicant’s] evidence.” The Office has not excluded the evidence, but has offered some reasons as to why it is not persuasive, such as in paper no. 36 and the Appendix attached thereto. A refusal to be persuaded by something is not the same thing as ignoring it.

Applicant has refers to the American Physical Society, with its spokesman Dr. Robert Park, as a “competitor” (page 29). While Dr. Park appears to have been critical of applicant’s work, such criticism is not the same thing as competition.

Applicant also implies (page 108) that Dr. Bernard Souw, who has been consulted during the examination of his applications, is also involved in work “competitive” to this own, which would produce a conflict of interest. The evidence offered by applicant, an article written by Dr. Souw, deals with a telescope array, which is neither an alternative form of hydrogen nor a new previously unappreciated source of energy, and thus does not appear to be competitive with the present “hydrino” or any battery based thereon. While the biographical sketch at the end of the article mentions his involvement in consulting work having to do with microwave plasma devices and CVD diamond synthesis, this would not amount to competition with the present invention or the underlying hydrinos. Diamonds are a form of carbon, and thus are not in competition with hydrogen. Microwave plasma devices are not necessarily related to hydrogen, since they are a type of device or machine.

Regarding applicant’s allegations of Balmer line broadening being an indication of the presence of hydrinos, see the enclosed article by Luque *et al.*, which deals with Stark broadening of the H-alpha and H=beta lines.

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Regarding various other arguments, please see the attached Appendix, and the enclosed articles, which are cited therein.

This is a RCE of applicant's earlier Application No. 09/110,717. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Kalafut whose telephone number is 571-272-1286. The examiner can normally be reached on Mon-Fri 8:00 am-4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sjk


STEPHEN KALAFUT
PRIMARY EXAMINER
GROUP
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